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09/665,627	09/19/2000	Jean-Francois Le Pennec	909.0030USU	5560

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EXAMINER

LAFORGIA, CHRISTIAN A

ART UNIT

PAPER NUMBER

2131

DATE MAILED: 07/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/665,627

Applicant(s)

LE PENNEC ET AL.

Examiner

Christian La Forgia

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2-7, 9-23 is/are rejected.
- 7) ☒ Claim(s) 8 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. The amendment filed on 18 April 2005 has been noted and made of record.
2. Claims 1-23 have been presented for examination.
3. Claim 2 has been cancelled as per Applicant's request.

### ***Response to Arguments***

4. Applicant's arguments with respect to claims 1 and 3-23 have been considered but are moot in view of the new ground(s) of rejection.
5. See further rejections that follow.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 14-18, and 20-22 are rejected under both 35 U.S.C. 102(a) and 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,058,383 to Narasimhalu et al., hereinafter Narasimhalu.
8. As per claims 14, 21, and 22, Narasimhalu teaches a method, for use in a server or client system, of determining that a file is virus-free comprising the steps of:
  - determining whether a virus-free certificate is integrated within a file is certified as virus-free (Figures 8 [block 270], 9 [block 284], column 8, line 31 to column 9, line 4);
  - if a certificate is integrated within the file:

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- authenticating the virus-free certificate, said virus-free certificate comprising a certificate signature (Figures 8 [block 280], 9 [block 280], column 8, line 31 to column 9, line 4);
- authenticating the file, said virus-free certificate comprising a file signature, said file signature certifying that said file has been declared virus-free by a virus-free certifying authority (Figure 9, column 8, line 53 to column 9, line 4).

9. Regarding claim 15, Narasimhalu teaches that the step of authenticating the file comprises the further steps of decrypting the file signature using a public key comprised in the virus-free certificate, hashing the file to generate a file digest; and comparing the decrypted file signature with the generated file digest (Figures 9, 10, column 8, line 53 to column 9, line 17).

10. Regarding claim 16, Narasimhalu teaches that the step of authenticating the virus-free certificate comprises the further step of validating the virus-free certificate (Figure 9, column 8, line 53 to column 9, line 4).

11. With regards to claim 17, Narasimhalu teaches that the step of validating the virus-free certificate comprises the further step of determining whether the virus-free certificate is valid or not; if the virus-free certificate is not valid: requesting a virus-free certificate update or an updated virus-free certificate update to a virus-free certificate authority (Figure 9, column 8, line 53 to column 9, line 4).

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12. Regarding claim 18, Narasimhalu teaches that the virus-free certificate further comprises a file identification; a virus-free certificate authority identification; and a public key for decrypting the file signature (Figure 3, column 6, line 47 to column 7, line 13).

13. Regarding to claim 20, Narasimhalu teaches that a product name within a file header comprises means for identifying the integrated virus-free certificate or not (Figures 3, 9, column 6, line 47 to column 7, line 13, column 8, line 53 to column 9, line 4).

***Claim Rejections - 35 USC § 103***

14. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

15. Claims 1, 3-7, 9-13, 19, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Narasimhalu, in view of U.S. Patent No. 5,892,904 to Atkinson et al., hereinafter Atkinson.

16. As per claims 1, 12, 13, and 23, Narasimhalu teaches a method, for use in a virus-free certificate authority, of generating a virus-free certificate certifying that a file is virus-free comprising the steps of:

receiving a request for a virus-free certificate request for a file from a server or a client system, said virus-free certificate request comprising the file for which the virus-free certificate request is being made (column 4, lines 47-50, i.e. verifying the trustworthiness or guarantee the object or file is virus-free);

if the file has not been certified as virus-free:

determining whether the file is virus-free or not (column 5, lines 21-25, i.e. certifying authority is responsible for certifying objects meet the defined trust criteria);

if the file is declared virus-free:

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generating a virus-free certificate comprising a file signature for certifying that said file is declared virus-free by the virus-free certificate authority (column 6, lines 35-41);

sending back in response to the virus-free certificate request the file with the integrated virus-free certificate (column 6, lines 35-41).

17. Narasimhalu does not disclose determining whether a virus-free certificate is integrated in the file; and integrating the generated certificate in the file.

18. Atkinson discloses determining whether a virus-free certificate is integrated in the file; and integrating the generated certificate in the file (column 2, lines 33-53).

19. Both Narasimhalu and Atkinson teach using certificates associated with files to ensure that the file is virus-free. Atkinson differs from the teaching of Narasimhalu in the sense that Atkinson discloses integrating the certificate in the file.

20. It would have been obvious to one of ordinary skill in the art at the time the invention was made to integrate the certificate in the file, since Atkinson discloses at column 2, lines 33-53 that such a modification would verify the source of the file, thereby ensuring its authenticity which reduces the risk of contracting a computer virus or other malicious executable files.

21. Regarding claim 3, Atkinson teaches that the file comprised in the virus-free certificate request contains an integrated virus-free certificate (Figure 3 [block 120], column 2, lines 33-53).

22. Regarding claim 4, Atkinson teaches the steps of:

if the file comprises an integrated virus-free certificate, determining whether the virus-free certificate integrated in the file has been previously generated by the virus-free certificate

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authority, and if that is the case, updating the virus-free certificate (column 6, line 44 to column 7, line 10);

if the virus-free certificate integrated in the file has not been previously generated by the virus-free certificate authority, then generating a new virus-free certificate (column 17, line 65 to column 18, line 11).

23. Regarding claim 5, Atkinson teaches that the file further comprises a file header comprising:

- a non encrypted file signature (column 6, line 44 to column 7, line 10);
- a file length (column 6, line 44 to column 7, line 10);
- a product name (column 6, line 44 to column 7, line 10).

24. Regarding claims 6 and 19, Atkinson teaches that the step of integrating the virus-free certificate in the file comprises the further step of:

- appending the virus-free certificate to the file (column 6, lines 44-58).
- modifying the file header, preferably:
  - the non encrypted file signature (column 6, line 44 to column 7, line 10);
  - the file length (column 6, line 44 to column 7, line 10);
  - a product name, said product name comprising means for identifying the integrated virus-free certificate (column 6, line 44 to column 7, line 10).

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25. Regarding claim 7, Atkinson teaches that the step of determining whether the file is virus-free or not comprises the further step of executing one or a plurality of anti-virus programs on said file for detecting viruses (column 2, lines 5-53).

26. Regarding claim 9, Atkinson teaches that the virus-free certificate further comprises a file identification; a virus-free certificate authority identification; a public key for decrypting the file signature; and a virus-free certificate also comprises a certificate signature for authenticating purposes (Figure 4, column 6, line 8 to column 7, line 10).

27. Regarding claim 10, Atkinson teaches the further steps of identifying the server or client system where the file comprising the integrated virus-free certificate is stored; updating the file with the integrated virus-free certificate (Figure 4, column 6, line 8 to column 7, line 10).

28. Regarding claim 11, Atkinson teaches that the step of generating a file signature comprises the further steps of hashing the file to generate a file digest; encrypting the file digest using a private key (Figure 4, column 6, line 8 to column 7, line 10).

### ***Double Patenting***

29. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686

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F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

30. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

31. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

32. Claims 1 and 3-23 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of copending Application No. 09/665,040 in view of U.S. Patent No. 5,136,647 to Haber et al., hereinafter Haber, OR U.S. Patent No. 5,475,753 to Barbara et al., hereinafter Barbara, OR U.S. Patent No. 5,892,904 to Atkinson et al., hereinafter Atkinson.

33. The independent claims of the instant application disclose receiving a request for a virus-free certificate request for a file from a server or a client system, said virus-free certificate request comprising the file for which the virus-free certificate request is being made;

determining whether a virus-free certificate is integrated in the file;

if the file has not been certified as virus-free:

determining whether the file is virus-free or not;

if the file is declared virus-free:

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generating a virus-free certificate comprising a file signature for certifying that said file is declared virus-free by the virus-free certificate authority;

integrating the generated certificate in the file;

sending back in response to the virus-free certificate request the file with the integrated virus-free certificate.

34. Copending Application No. 09/665,040 independent claims recite receiving a virus-free certificate request for a file from a system;

the virus-free certificate request comprising a list of one or a plurality of anti-virus programs to be executed on the file by the certificate authority to determine whether the file is virus-free or not;

determining whether the file is virus-free or not;

if the file is declared virus-free by the virus-free certificate authority:

generating a virus-free certificate comprising a file signature for certifying that said file is declared virus-free by the virus-free certificate authority; and

sending back in response to the virus-free certificate request the virus-free certificate.

35. Copending Application No. 09/665,040 does not disclose where the virus-free certificate is integrated in the file.

36. Haber discloses integrating a certificate into a file (column 8, lines 17-39).

37. It would have been obvious to one of ordinary skill in the art at the time the invention was made to integrate the virus-free certificate into the file, since Haber discloses at column 8, lines 17-39 that such a modification prevents a user from tampering with said file.

38. Barbara discloses integrating a certificate into a file (column 5, lines 49-63).

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39. It would have been obvious to one of ordinary skill in the art at the time the invention was made to integrate the virus-free certificate into the file, since Barbara discloses at column 5, lines 29-63 that such a modification would allow a user to verify the file.

40. Atkinson discloses integrating a certificate into a file (Figure 3 [block 120], column 2, lines 33-53).

41. It would have been obvious to one of ordinary skill in the art at the time the invention was made to integrate the virus-free certificate into the file, since Atkinson discloses at column 2, lines 32-53 that such a modification would assure the recipient of the identity of the publisher, i.e. verify authenticity.

42. This is a provisional obviousness-type double patenting rejection.

#### *Allowable Subject Matter*

43. Claim 8 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

44. The following is a statement of reasons for the indication of allowable subject matter:

Claim 8 was indicated as allowable subject matter in copending case 09/665,040.

#### *Conclusion*

45. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christian La Forgia whose telephone number is (571) 272-3792. The examiner can normally be reached on Monday thru Thursday 7-5.

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46. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

47. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christian LaForgia  
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